

**REMARKS**

The above amendments and following remarks are responsive to the points raised in the July 2, 2004 non-final Office Action. Upon entry of the above amendments, Claims 1, and 16-20 have been amended. Claims 1-21 will be pending. Claims 13-15 and 21 have been withdrawn from further consideration as being drawn to a non-elected species. No new matter has been introduced. Entry and reconsideration are respectfully requested.

**Response to Election of Species Requirement**

Applicant has been required to elect one of the following two “patentably distinct species”:

- “I. First and second embodiments, figs. 1-3 and Fig. 3, respectively (corresponding to claims 1-12 and 16-20).
- II. Third embodiment, Figs. 5-10 (corresponding to claims 13-15 and 31).”

Upon election of one of the above-identified “patentably distinct species”, Applicant has also been required to provide a listing of all of the claims readable thereon. The Examiner urges that no claim is generic.

On June 25, 2004, Applicant, in response to an Examiner initiated telephone interview with Applicant’s below signed representative, provisionally elected Species I, Claims 1-12 and 16-20. The claims directed to non-elected Species II, i.e., Claims 13-15, and 21 have been withdrawn from further consideration by the Examiner.

Applicant, as noted above, made the forgoing provisional election with traverse and respectfully submits that the election of species requirement is improper and hereby requests withdrawal thereof. Notwithstanding Applicant's belief that the election of species is improper, Applicant also believes that at least Claim 1 is generic to each of the two identified species.

Section 803 of the Manual of Patent Examining Procedure (MPEP) indicates that "there are two criteria for restriction between patentably distinct inventions" as follows (emphasis added) to wit:

The inventions must be independent ...; and,

There must be a serious burden on the examiner if restriction is not required...

Applicant respectfully submits that in the instant case the identified species of Figures 1-10 are properly presented in the same application and that no undue diverse searching would be required. As such, the Examiner has not satisfied the two criteria identified in Section 803 of the MPEP.

In accordance with the election of species requirement, Applicant hereby confirms the previous provisional election of Species I (Figures 1-3). Claims 1-12 and 16-20 are readable on elected Specie I.

For the foregoing reasons, it is respectfully submitted that the election of species requirement is improper and should be withdrawn and an action on the merits of all of the identified species are respectfully submitted.

**Response to Rejection under 35 U.S.C. § 102(b)**

Claims 1, 16, 17, and 20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by US Patent 5,825,505 to Toyoda et al. (Toyoda). Applicant traverses this rejection.

Claims 1, 16, 17, and 20 have been amended to recite an image reading apparatus, an image reading system, a control method for an image reading apparatus, and a peripheral device, respectively, including the recitation of a power supply controller selectively using one of at least two power supplies and an operation mode determination unit determining one of a plurality of operation modes in accordance with the one of at least two power supplies selected by the power supply controller. Applicant respectfully submits that Toyoda does not teach or suggest the invention as recited in Claims 1, 16, 17, and 20, and in particular, a power supply controller selectively using one of at least two power supplies and an operation mode determination unit determining one of a plurality of operation modes in accordance with the one of at least two power supplies selected by the power supply controller.

The Examiner, on Page 2 of the July 2, 2004 non-final Office Action, urges that the Toyoda apparatus:

“has a plurality of operation modes that require different consumption powers, the operation modes including a full print mode, which is a full power print mode, and thin print mode, which is an energy saving mode (col. 4, lines 48-67, col. 10, lines 19-67). The controller selectively uses an AC power supply, a battery, and a car battery. When it is detected that AC power is connected (BAT/AC=0), the full print mode determined to be the operation mode, and when it is detected that a battery is used (BAT/AC=1), the thin print mode is determined to be the operation mode.”

Toyoda, however, does not disclose a controller that selects one of at least two power supplies in which an operation mode determination unit determines one of a plurality of operating modes in accordance with the one of the at least two power supplies selected by the controller, as recited in Claims 1, 16, 17, and 20. The Toyoda apparatus merely operates in a specific mode on the basis of the specific power supply arrangement to which the disclosed apparatus may be connected for operation. The Toyoda controller, itself, does not select one of at least two power supplies and operate in any specific mode on the basis of which power supply was selected by the controller, as is the case in the present invention. In Toyoda, the user of the disclosed apparatus selects the power supply not a power supply controller. As such, the invention as recited in independent Claims 1, 16, 17, and 20 are distinguished over the prior art reference of Toyoda. Dependent Claims 2-12, which depend from Claim 1, are likewise distinguished over Toyoda for at least the same reasons as Claim 1. Accordingly, the rejection under 35 U.S.C. § 102(b) is improper and should be withdrawn.

**Response to the Rejections under 35 U.S.C. § 103(a)**

Claim 12 has been rejected under 35 U.S.C. § 103(a) as being obvious over Toyoda in view of US Patent 6,708,279 to Takanaka. Claims 2-5, 9, and 10 have been rejected under 35 U.S.C. § 103(a) as being obvious over Toyoda in view of US Patent 5,956,158 to Pinzarrone et al. (Pinzarrone). Claims 18 and 19 have been rejected under 35 U.S.C. § 103(a) as being obvious over Toyoda. Applicant respectfully traverses these rejections.

In addition the differences between Claims 2-5, 9, 10, and 12 and Toyoda admitted by the Examiner, Claims 2-5, 9, 10, and 12 are further distinguished over Toyoda for the same reasons discussed above with respect to Claim 1. Neither of the secondary references of Takanaka nor Pinzarrone advance any teaching, suggestion, or motivation for providing a controller that selects one of at least two power supplies in which an operation mode determination unit determines one of a plurality of operating modes in accordance with the one of the at least two power supplies selected by the controller.

Claims 18 and 19 have been amended to recite a memory medium which stores a program for controlling an image reading apparatus and a program controlling an image reading apparatus, respectively, wherein one of at least two power supplies is selected by the power control circuit (Claim 18) or the power supply control circuit (Claim 19) and one of a plurality of operation modes is determined in accordance with the power supply selected by the power control circuit or power supply control circuit. These distinctions are consistent with those discussed above with respect to Claims 1, 16, 17, and 20, and such discussion is incorporated herein by reference. No where within Toyoda is it seen where Toyoda teaches, suggests, or otherwise renders obvious, the subject matter recited in Claims 18 and 19. As such, the subject matter of Claims 18 and 19 are distinguished over Toyoda.

In view of the above, the rejections under 35 U.S.C. 103(a) should be withdrawn and the rejected claims allowed.

**Allowable Subject Matter**

Claims 6-8 and 11 have, in effect, been objected to by the Examiner as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim. Applicant agrees that these claims are distinguished over the prior art, as well as 1-5, 9, 10, 12, and 16-20.

**CONCLUSION**

Applicant respectfully submits that Claims 1-12 and 16-20 are in condition for allowance and a notice to that effect is earnestly solicited.

U.S. Serial No. 09/834,078  
Amendment

Docket No. 1232-4706

**AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees which may be required for the timely consideration of this amendment, or credit any overpayment to Deposit Account No. 13-4503, Order No. 1232-4706.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

Date: August 27, 2004

By: 

Brian W. Brown

Reg. No.: 47,265

(202) 857-7887 Telephone

(202) 857-7929 Facsimile

**Correspondence Address:**  
Morgan & Finnegan  
Three World Financial Center  
New York, NY 10281-2101  
(212) 415-8700 Telephone  
(212) 415-8701 Facsimile